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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,967	07/24/2003	James E. Issler	03820-P0094A	1638

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ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD, CT 06905-5619

EXAMINER	
BRITTAIN, JAMES R	

ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,967	ISSLER, JAMES E.	
	Examiner	Art Unit	
	James R. Brittain	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-22 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Forstner (US 876341).

Forstner (figures 1-4) teaches a fastener system comprising a clasp, B, having an anchoring end, B^2, and a lace end B', the lace end adapted to hold a lace in the form of the strap, D; the anchoring end, B^2, having a first part and a second part where the first and second parts are movable away from and toward one another; a receiver, A, having a first receptacle and a second receptacle, A^4, for engaging the first and second parts, respectively; and wherein the clasp is removably joinable to the receiver (lines 8-12, 58-68) when the first and second parts are engaged with the first and second receptacles and, when the first and second parts are disengaged with the first and second receptacles, the clasp is separable from the receiver; wherein the first and second parts are, when an opening force is applied to the clasp, moved away from one another. The lace end, B', holds the strap, D, in position and this can inherently be a lacing system that holds an end of a lace in position on a shoe. There is nothing further claimed by applicant to the lacing system than what Forstner discloses. As to claim 22, the first and second parts of the anchoring end, B^2, are biased toward one another such that, when the opening force is removed, the first and second parts automatically move toward one another. In regard to claim

21, Forstner (figures 1-4) teaches a method of providing a fastening system comprising the steps of providing a clasp, B, having a receiver end and a lace end; extending a first part and a second part, B^2, from the receiver end; extending a holder from the lace end; providing a receiver, A, having a first receptacle and a second receptacle, A^4, for receiving the first and second parts, B^2, respectively; moving the first and second parts toward one another and into the first and second receptacles, respectively, to removably join the clasp with the receiver; and wherein the clasp is removably joinable to the receiver for closing an item and the clasp is separable from the receiver for opening the item (lines 8-12, 58-68). The strap is inherently usable in a lacing system for a shoe if so desired. As to claim 22, the step of moving the first and second parts, B^2, away from one another and out of the first and second receptacles, A^4, respectively, to separate the clasp from the receiver is taught by Forstner.

Response to Arguments

Applicant's arguments filed in response to the last office action have been fully considered but they are not persuasive.

The proposal was made in the interview of March 2, 2005 to include "a shoe in combination with the current claims" as indicated in the Interview Summary (Paper No. 03022005). The language "for a shoe" (claim 19, line 1; claim 21, lines 1-2) and "adapted to hold a lace of the shoe" (claim 19, lines 2-3) is not "a shoe in combination with the current claims". Applicant has chosen to amend neither claim in accordance with the language "a shoe in combination" that was presented in the interview of March 2, 2005. Applicant has chosen a claim construction to carefully avoid claiming a shoe in combination. The claims still lack novelty because of the unambiguous choice made by applicant to not claim the shoe in

combination, but rather seek to claim the subcombination alone with a statement of intended use. In response to applicant's argument that Forstner does not disclose, teach, or suggest application of the invention to a shoe (page 4, ¶1), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Neither claim 19 nor claim 21 attaches the receiver to a shoe or includes the step of attaching the receiver to a shoe, respectively. Applicant has chosen a claim construction bereft of any attachment to the shoe. The use of "for a" (claim 19, line 1; claim 21, line 1) and "adapted to" (claim 19, line 2) is language utilized as a statement of intended use and does not include the shoe in combination. The device of Forstner is fully capable of having the receiver, A, as shown in figure 3 secured to a shoe and the clasp, B, as shown in figure 4 secured thereto and attach a lace in the form of the strap, D, to the clasp. This analysis establishes that the claim construction is still such as to be drawn to the subcombination comprising the clasp and receiver adapted to hold a lace and the device of Forstner has structure inherently capable of performing in applicant's environment of intended use upon a shoe if so desired. Obviously, the device of Forstner is used as a rein coupling, but the clasp, B, is shown holding a rein, D, that can inherently be the held end of a lace. There is nothing further to the claimed lacing system than what Forstner discloses. There is no novelty in the broad scope of coverage applicant has chosen through claim construction. The lacing system is not claimed as a plurality of receivers and

clasps attached to a shoe with a lace slidably extending through the lace ends of the clasps. Applicant chose not to claim the combination as his lacing system. Instead, applicant has chosen a claim construction defining the lacing system as comprising a single subcombination of a clasp and receiver with the intended use being for a shoe. It is submitted that Forstner discloses structure that anticipates the scope of the claims as constructed.

Applicant's discussion with respect to Krauss (US 5379496) and Liu (US 6568105) is not pertinent because the claim construction applicant has chosen still does not avoid Forstner and since it is unknown if applicant will amend the claims or in what manner applicant may amend the claims, the issue of linkage between the combination of a lace fastener with a shoe and the fasteners used for reins as discussed in the interview of March 2, 2005 is not ripe for consideration.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is (571) 272-7065. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James R. Brittain
Primary Examiner
Art Unit 3677

JRB